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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,463	10/29/2001	Samuel H. Fleming	5038-137	1885

7590 10/29/2004

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EXAMINER
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LANEAU, RONALD

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/001,463

Applicant(s)

FLEMING, SAMUEL H.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-22,24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*Response to Amendment*

1. The amendment filed on 08/06/2004 has been entered. Claims 4, 5 and 23 are canceled and claims 1-3, 6-22 and 24-27 are now pending.

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 6-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim, et al. (5,299,295) or Havlovick, et al. (5,475,403) in view of Don Crabb, Intuit's Pocket Quicken Carries Benefits With It, Chicago Sun-Time, November 12, 1998, pg. 32.

Kim and/or Havlovick disclose Kim discloses a hand-held electronic checkbook apparatus that receives financial data from a user, contains electronics, a display including in touch-sensitive LCD form, keyboard, processor, printer for printing an electronic check, input/output port capable of transmitting and receiving data and the method thereof which procures the checkbook, enters data into predefined fields including payee and a numeric field and applying a signature to the electronic check after printing. See the entire patent and specifically, Abstract; Fig. 1-, cols. 1-5.

However, neither Kim nor Havlovick disclose that the input device is a touch-sensitive LCD or that the keyboard is simulated and rendered on a display, for operating the simulated

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keyboard. Kim discloses that manually recording check transaction and writing checks is time consuming and often cumbersome and when hurried individual often enter a serried of disbursed checks in the check registry without calculating the checking account balance resulting in an unavailable current balance, thus increasing the likelihood of overdrawn accounts and hurried calculations compound this problem and add to reconciliation time and thus a handheld electronic checkbook was created (col. 1).

Havlovick discloses that downscaling of product sizes is one of the most important considerations in the development of electronic products and the acceptability and therefor success of many products is directly dependent upon their relatively miniature size and light weight, including electronic checkbooks (cols. 1-2). Crabb discloses that Pocket Quicken, i.e. financial software that can be used in conjunction with Quicken99, and tracks and organizes multiple accounts including checks, cash, deposits, withdrawals, etc. on your Palm, i.e. acts as a checkbook, without the checkwriting function on a Palm, PDA. Palm devices have a touch-sensitive display/input device and at least as of 1999 have a tiny virtual keyboard for tapping out letters using the stylus and as it hotsyncs to Quicken which has had Online Banking, i.e. Internet linking to financial account data maintained by a financial institution remote from a user and checkbooks with check printing and reconciliations and alerting to discrepancies and account information through the web since at least 1999.

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a Palm with the Quicken features with the apparatus/method of Kim and or Havlovick for the specific reasons set forth above.

As per claims 19-21, Havlovick discloses as set forth above. Havlovick discloses that the electronic checkbook prompts the user via a display to complete various actions to be taken and the software includes the ability to allow users to enter in dates on which bills are due and the software presents through the electronic checkbook display the bills that are due and prompts the user whether or not to write a check and if the response is yes a check is written (Figs. 11; cols. 4 and 16).

#### ***Response to Arguments***

4. Applicant's arguments filed 08/06/2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In response to applicant's arguments that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21

USPQ2d 1941 (Fed. Cir. 1992). Applicant's arguments are deemed unpersuasive and claims 1-3, 6-22 and 24-27 have been finally rejected.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RL

Ronald Laneau  
Examiner  
Art Unit 3627

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*Handwritten signature: Ronald Laneau 10/27/04  
Primary Examiner*